

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Sontheimer <i>et al.</i>	Examiner:	Chen, Shin Lin
Patent No:	7,678,759	Group Art Unit:	1632
Issue Date:	May 16, 2010	Confirmation No.:	7705
Serial No.:	10/686,782		
Filing Date:	October 17, 2003		
Title:	Diagnosis and Treatment of Neuroectodermal Tumors		

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO DECISION DISMISSING
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705 (d)**

This paper is filed responsive to the Decision (mailed on August 18, 2010), dismissing the request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705 (d) (filed on May 17, 2010). The Decision set forth a deadline of two (2) months from the mailing date, *i.e.*, on October 18, 2010, to respond. Applicants therefore submit that the present Response is timely.

The Office of Petitions (the "Office") and the Applicants disagree with respect to the calculation of the number of days of B delay. Applicants respectfully maintain disagreement with the Office's calculation of the B delay for reasons set forth below.

Regarding the period of B delay, two periods of time are relevant and are discussed in turn below.

- (1) The period of time over three years from the filing of the application until the filing of a Request for Continued Examination (RCE)

The application was filed on October 17, 2003 and the first RCE was filed on October 31, 2007. Thus, the date that is three years from the date of filing of the application is October 17, 2006. The Office calculated the period of time over

three years from the filing of the application until the filing of an RCE as the period from October 18, 2006 to October 30, 2007, inclusive of both endpoints. This time period is 378 days, as indicated in the Decision.

(2) The period of time from the filing of a notice of appeal until the filing of a Request for Continued Examination.

A notice of appeal was filed on May 25, 2007. The Office takes the position that the period of time from the filing of the notice of appeal until the day before the filing of the RCE (*i.e.*, May 25, 2007 until October 30, 2007, inclusive of endpoints) should be deducted from the time period calculated in part (1) above. This time period is equivalent to 159 days. In support of this position, the Office cites 35 U.S.C. 154(b)(1)(B)(ii), which provides that “any time consumed by *appellate review by the Board of Patent Appeals and Interferences* or by a Federal Court” (emphases added) is excluded from the calculation of B delay. However, appellate review does *not* commence upon the filing of a notice of appeal, but rather, upon the filing of an Examiner’s reply to the applicant’s Appeal Brief. No time was consumed by appellate review because no Examiner’s reply had been filed. Thus, the time period from May 25, 2007 until October 30, 2007 should *not* be excluded from the calculation of B delay.

Accordingly, the proper calculation of the B delay is at least 358 days (the full period specified in part (1) above). Therefore, Applicants should be entitled to a patent term adjustment of 617 days (468 days of A delay plus 378 days of B delay minus 209 days of applicant delay). Appropriate correction to the patent term adjustment indicated on the face of the above-referenced patent is respectfully requested.

The Office acknowledged receipt of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) that was filed with the petition on May 17, 2010. Applicants believe that no fees are due with this response. In the event that any fees are believed due, a Notice to that effect is respectfully requested. If, for any reason, this Response is found to be non-compliant or otherwise improper, please contact the undersigned agent by telephone at 1 (617) 248-4013.

Respectfully submitted,

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Date: October 14, 2010

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